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09/785,700	02/16/2001	Robert M. Szabo	6169-156	4280
40987 7590 11/04/2008 AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
LASTRA, DANIEL				
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3688				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/785,700

**Applicant(s)**

SZABO ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

3688

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No./Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-9 have been examined. Application 09/785,700 (METHOD AND APPARATUS FOR STIMULATING COMMERCE) has a filing date 02/16/01.

**Response to Amendment**

2. In response to Final Rejection filed 07/18/2008, the Applicant filed an RCE on 08/29/2008, which amended claim 1 and cancel claims 10-24.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "the merchant specified product" in line 21. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 2001/0014868) in view of Barenbaum (US 2001/0039514).

As per claims 1, Herz teaches:

A computer-implemented method of providing promotional material to consumers comprising:

establishing a computer communications session between the merchant computer system and a third-party remote shopping stimulation system (see paragraph 246) ;

reading with said third-party remote shopping simulation system consumer purchase information from the merchant computer system, said consumer purchase information comprising consumer identifying information, purchased product information (see paragraph 246) and communication mode information indicating in which communication mode promotional material can be delivered to a particular consumer (see paragraph 51);

*wherein the purchased product information includes product expiration information and product identifying information* (see paragraph 246 "need to upgrade a system");

based at least in part on said consumer purchase information, identifying one or more potential consumers who have previously purchased one or more of the *detected* products (see paragraphs 246 and 249 "previously purchased computer components");

determining based upon predetermined product attributes irrespective of merchant inventories that at least one of the merchant-specified products is an obsolete product (see paragraph 246 "computer system in need of upgrade") when a new or alternate version of the at least one of the merchant-specified products has at least one among current availability and expected availability within a predetermined time period

(see paragraph 246 "upgrades to a computer"), and ascertaining which of said identified potential consumers previously purchased at least one of said obsolete products (see paragraphs 246 and 24 "elapsed time period to previous purchase");

in said third-party remote shopping stimulation system, generating promotional material for said new or alternate version of the at least one of the merchant-specified products of the one or more potential customers ascertained as having previously purchased the at least one of said merchant-specified product identified as an obsolete product, and associating said promotional material corresponding to said new or alternate version of the at least one of the merchant-specified products with said ascertained consumers (see paragraphs 246 and 248 "offering a upgrade offer to a existing computer system previously purchased by a user")

determining for each of said identified consumers whether promotional material can be delivered via regular mail, electronic mail, telephone communication, or Internet communication, wherein the determination for each particular identified consumer is based upon communication mode information uniquely corresponding to the particular consumer (see paragraphs 31, 37, 51). Herz teaches obtaining demographic information about shoppers (see paragraph 31) and using said information to target offers to said shoppers mailing address or electronic mail (see paragraph 51).

making said promotional material available to said identified consumers using a promotional material delivery system (see paragraph 246)

wherein said delivery system delivers promotional material to each particular identified consumer via the communication mode indicated by the communication mode

information uniquely corresponding to the particular consumer (see paragraphs 31, 37, 51).

Herz does not teach:

*detecting products to be promoted in an inventory management system of a merchant computer system; receiving in the third-party remote shopping stimulation system a merchant request from the merchant computer system to stimulate commerce for the detected products.* However, Barenbaum teaches a system that detects over-stocked inventories and target offers to potential customers based upon said detection of over-stocked supply (see paragraph 18). Furthermore, Barenbaum teaches that said potential customers for said target offers are selected based upon said potential customers' previous purchases (see paragraph 35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would target offers to potential customers based upon detection of an over-stocked inventory, as taught by Barenbaum in order to better control an inventory size, avoid a clog up situation in a merchant's back-room storage (see Herz paragraph 311) and also in order to try to sell products that are near to expire (i.e. "abundant supply of summer dresses and approaching the end of summer"; "over-stocked strawberries that will be worthless in a few days"; see Barenbaum paragraph 18).

As per claim 2, Herz teaches:

said identifying step further comprising determining a product consumption rate from said consumer purchase information to identify said one or more potential

consumers of the least one merchant-specified product (see paragraphs 298-299 "incorporating time in our price point analysis").

As per claim 3, Herz teaches:

wherein said promotional material and said consumer purchase information include person-to-person transactions and Internet-based transactions (see paragraphs 251 and 262).

As per claim 4, Herz does not expressly teach:

wherein each said step is performed responsive to the merchant system detecting a business necessity corresponding to said new or alternate versions of said product identified as an obsolete product, wherein said business necessity corresponds to a merchant of said new or alternate versions of said product identified as an obsolete product having excess inventory of said new or alternate versions of said product identified as an obsolete product. However, Barenbaum teaches a system that detects over-stocked inventories and target offers to potential customers based upon said detection of over-stocked supply (see paragraph 18). Furthermore, Barenbaum teaches that said potential customers for said target offers are selected based upon said potential customers' previous purchases (see paragraph 35) Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Herz would target offers to potential customers based upon detection of an over-stocked inventory, as taught by Barenbaum in order to better control an inventory size, avoid a clog up situation in a merchant's back-room storage (see Herz paragraph 311) and also in order to try to sell products that are near to expire

(i.e. "abundant supply of summer dresses and approaching the end of summer"; "overstocked strawberries that will be worthless in a few days"; see Barenbaum paragraph 18).

As per claim 5, Herz teaches:

wherein said consumer purchase information is read from a purchase history database comprising consumer purchase information for a plurality of different merchants, and wherein the third-party remote shopping stimulation system responds to merchant requests from said plurality of different merchants (see paragraphs 21-22).

As per claim 6, Herz teaches:

wherein the one or more merchant-specified products comprise a service (see paragraph 4).

As per claim 7, Herz teaches:

said product information comprising product expiration information and product identifying information wherein said step of identifying one or more potential consumers of products is additionally based upon the expiration information of products (see paragraph 246 "need to upgrade a system").

As per claim 8, Herz teaches:

wherein said promotional material made available to said identified consumers is in electronic format (see paragraph 251).

As per claim 9, Herz teaches:

wherein said promotional material made available to said identified consumers is in printed format (see paragraph 21).



***Response to Arguments***

5. Applicant's arguments filed 08/29/2008 have been fully considered but they are not persuasive. The Applicant argues that the Examiner is incorrect in equating "obsolete product" with a "computer system in need of upgrade" because according to the Applicant, a Webster dictionary defines "obsolete" as "no longer in use or no longer useful" and according to the Applicant, in Herz, the computer is being used and therefore, it is not obsolete. The Examiner answers that Applicant's specification defines "obsolete" as the life cycle of a product, where said product typically does not wear out but rather becomes obsolete or otherwise undesirable (see page 11, line 20 – page 12, line 6). Herz teaches recommending upgrades to a computer system because demands and performance problems (i.e. obsolete) due to the life cycle of said product (see paragraph 246). Therefore, contrary to Applicant's argument, Herz teaches Applicant's claimed limitation.

The Applicant argues that Barenbaum does not teach "obsolete" products. The Examiner answers that Barenbaum's woman store approaching the end of the summer season with an abundant supply of summer dresses (see paragraph 18) would read Applicant's Specification example of an "obsolete" product where it recites that "trendy clothing that may not wear out but a consumer of such clothing may not wish to wear last season's fashion" would be consider obsolete or undesirable (see Applicant's specification page 12, lines 1-7). Therefore, contrary to Applicant's argument, Herz teaches Applicant's claimed limitation.

The Applicant argues that Herz does not teach determining the appropriate communication mode for delivering the promotional material based upon communication mode information uniquely corresponding to the particular consumer because according to the Applicant, Herz is concerned in targeting shoppers based upon demographic information. The Examiner answers that Applicant's specification defines the limitation of "determining the appropriate communication mode for delivering the promotional material based upon communication mode information uniquely corresponding to the particular consumer" as simply obtaining consumer identifying information (i.e. demographic information) from said consumers such as email, phone, address and using said demographic information in order to target promotion to said consumers based upon said demographic information (see Applicant's specification page 11, lines 1-5). Herz teaches obtaining demographic information about shoppers (see paragraph 31) and using said information to target offers to said shoppers mailing address or electronic mail (see paragraph 51). Therefore, contrary to Applicant's argument, Herz teaches Applicant's claimed limitation.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
October 31, 2008